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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,669	12/21/2000	Brian M. Siegel	50N3787	5754

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EXAMINER

CHANG, SABRINA A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,669

Applicant(s)

SIEGEL ET AL.

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 17-24, 28, 31 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 17-24, 28, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

Applicant's cancellation of claims 8-16, 25-27, 29-30 and 33-41 have been fully considered.

Response to Arguments

Applicant's arguments, see Paper 4, filed 3/8/04, with respect to the rejection(s) of claim(s) 1-41 under 35 U.S.C. 102(c) and 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bianco (Patent) and Field (Article).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 7, 28, 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over the personal barcode scanning technology taught in the article "Swipe Your Shopping" (Field, Chris. March 11, 1998. The Times) in view of Bianco, U.S. Patent No. 5,047,614.

Field discloses the integration of barcode scanning technology in everyday items (items that have a main function that is different from scanning bar codes) - including a cellular phone and a ballpoint pen. Such dual-functionality devices are designed to give shoppers portable scanning power at home, in the store or on the move, enabling them to scan barcodes on any product. The data from the scanned barcode is stored in the pen and downloaded when the pen is

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connected to a home PC via a “data well”. Consumers can then order the goods by going online (inherently comprising connection to the Internet and direction to a URL) to the store and uploading the barcodes.

Field does not explicitly disclose that the bar code scanner is embedded in a consumer good that lacks the capacity for data transmission – the pen is capable of both wireless and contact-based data transmission.

Bianco teaches a method and means to aid a consumer while shopping. A consumer uses a bar code reading terminal to scan the barcodes of items that she wishes to purchase [Col 5, Line 5]. A smart card (removable memory) is inserted into a slot in the terminal where it is left while data is being accumulated [Col 5, Line 20]. The smart card is removed from the terminal and used elsewhere to retrieve the desired product information – to facilitate an eventual purchase by the consumer [Col 5, Line 32]. One of the advantages of the system is simple modularity: the ability to own multiple smart cards (removable memory stores) so that additional data may be recorded even while one of the cards is being used elsewhere to make purchases [Col 5, Line 15].

Bianco does not explicitly teach that the scanning and storage device are embedded in a “portable consumer good” – electronic or otherwise. Specifically, Bianco does not explicitly disclose that the scanner and memory are encased in a “good” that has a main function that is different from scanning bar codes [Applicant’s specification, Page 9].

However, both the barcode scanning device of Bianco and embedded barcode scanning devices in Field serve the same purpose: convenient and timely storage of information about a customer’s desired purchases for later use – by giving the consumer the opportunity to

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“remember” items for later, vendors and retailers increase the likelihood of receiving revenue from the resulting transactions.

It would have been obvious to modify the system of Field - whereby a consumer uses a barcode scanner embedded in a consumer good to select desired goods, transfers the data to a computer to learn more about the selected products via the Internet - to transfer the data from the scanner to the computer using any means – connected or otherwise. Specifically, using removable memory stores to transfer data from a scanning device to an ordering computer, as taught by Bianco, has such advantages as allowing a customer to store more information across multiple cards – thereby eliminating restraints on their use of the scanning device when ordering items.

In specific reference to claims 2-5, the specific type of device in which the barcode reader is embedded, whether electronic or not, does not lend to an improvement to the system. The purpose of incorporating the scanner into another device is centered on the device’s functionality as an apparatus for something other than barcode scanning.

In specific reference to claim 6, the purpose is to be able transfer the data from the device to another medium. The specific type of removable memory used - whether smart card, flash memory, or otherwise – does not in and of itself have an unpredictable result.

Claims 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Qode, as described in the webpages of www.qode.com excised using The Wayback Machine – web.archive.org – dated 10/18/2000, the article “Ger Ready to Pocket a Personal E-shopper” (Joshi, Pradnya. Oct. 22, 2000. South Florida Sun – Sentinel) and the QRS Press Release “Qode

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"Teams with QRS to Give On-land and On-line Retailers Advanced Marketing Capabilities" – dated Oct. 03, 2000.

The Qoder is an optical reader the size of a car key that scans and stores up to 100 bar codes printed on product packaging [Pradnya] (scanner converting a printed code of a selected primary consumer product into machine-readable information representative of said code). A user then connects Qoder to her computer [Pradnya] (a computer adapted to receive said machine-readable information from said scanner). The Qode service allows the user to comparison-shop online from the Qode site (inherently comprising computer couplable to a server via the Internet) for the best price on the products they have scanned and get a list of similar items [Pradnya] (list of secondary consumer products is a list of consumer products analogous to said selected primary consumer products). The Qode service also maintains a database of product and vendor information [QRS Press Release] (a database couplable to said server and storing information representative of a universal product code for each of a plurality of primary consumer products). Qode provides the consumer with maps and directions to the nearest location where a desired product is offered, and if the product is available online [Qode website – Retailer Solution] (said server adapted to retrieve and transmit said related consumer product information to said computer, said related consumer product information comprising a list of one or more secondary consumer products that are related to said selected primary consumer product; information representative of product pricing and availability at various vendors for each primary and secondary consumer product). Further, Qode delivers to consumers promotions related to their desired products [Qode website – Manufacturer Solution].

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In specific reference to claim 18, Qode does not explicitly disclose that the secondary list of items is comprised of products that are complementary to the consumer's primary selected items. However, it is a well-established business principle that vendors use promotion to increase the size of a potential sale to a customer. Specifically, advertisement of complementary products (or cross-selling) is widely used to entice a buyer to purchase more. In that Qode discloses the creation of "promotions" matched to the consumer's primary list of products, it would have been obvious to one skilled in the art at the time that such promotions include not only discounts for the list of primary products but also cross-selling opportunities in order to entice the consumer to purchase more.

In specific reference to claim 23 Qode does not explicitly disclose that the database includes information representative of product specifications and satisfactions ratings for each primary and secondary consumer product. The information being stored in the database is merely non-functional in the context of the entire system. Where the Qode database already stores information regarding a product's size, price, color, availability, location, etc. [Press Release – QRS] it further would have been obvious to provide any relevant product information, such as satisfaction ratings, in order to provide the consumer with the opportunity to make the most informed buying decision possible.

Conclusion

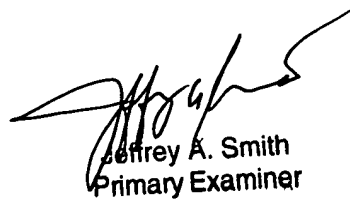
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Smith can be reached on 703 308 3588. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC



Jeffrey A. Smith
Primary Examiner